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**REMARKS**

The present application includes pending claims 1-8, 10-20, and 22-24, all of which have been rejected. By this Amendment, claim 24 has been amended to correct a typographical error, while claims 25-102 have been added. Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-8, 10-20, and 22-24 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,549,937 (the "Auerbach '937 patent").

**I. The Rejection Of Claims 1-8, 10-20, and 22-24**

The Auerbach '937 patent was filed July 21, 1999, and issued April 15, 2003. The present application was filed on August 30, 1999, less than three months from the effective filing date of the Auerbach '937 patent.

**A. Identification Of Claims 1-43 Of The Auerbach '937 Patent**

Turning first to the rejection of claims 1-8, 10-15, and 24, Applicant hereby identifies the Auerbach '937 patent, in order to comply with the requirements of 37 C.F.R. §1.607(c). In particular, Applicant identifies claims 1-43 of the Auerbach '937 patent under 37 C.F.R. §1.607(c). Applicant respectfully submits that claims 1-8, 10-15, and 24 of the present application correspond exactly or substantially to claims 1-43 of the Auerbach '937 patent.

As set forth above, new claims 25-102 have been added. These claims were originally filed on April 14, 2004, in United States Patent Application No. 10/824,038, which is a continuation of the present application. Applicant also respectfully submits that claims 25-102

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of the present application correspond exactly or substantially to claims 1-43 of the Auerbach '937 patent.

**B. Statement Showing That Applicant Is Entitled To Judgment**

37 C.F.R. § 1.608(a) states the following:

When the effective filing date of an application is three months or less after the effective filing date of a patent, before an interference will be declared, either Applicant or Applicant's attorney or agent of record shall file a statement alleging that there is a basis upon which Applicant is entitled to a judgment relative to the patentee.

The present application was filed August 30, 1999, which is less than three months after the July 21, 1999 filing date of the Auerbach '937 patent.

Pursuant to 37 C.F.R. § 1.608(a), Applicant alleges that there is a basis upon which Applicant is entitled to a judgment relative to Auerbach et al, the patentees of the Auerbach '937 patent. In particular, Applicant actually reduced to practice the invention of claims 1-8, 10-15, and 24-102 prior to July 21, 1999, the effective filing date of the Auerbach '937 patent.<sup>1</sup>

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<sup>1</sup> Although not specifically relevant to the rejection of claims 1-8, 10-20, and 22-24, Applicant also actually reduced to practice the invention described in claims 16-20, and 22-23 of the present application before the effective filing date of the Auerbach '937 patent.

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## **II. Inherency Rejections**

Each of claims 16-20, and 23 stand rejected as including “inherent features”. With respect to claim 6:

In considering claims 6 and 16, the claims include limitations that are inherent of instant messaging systems and limitations that are substantially the same as claims 1 and 24; therefore the same grounds of rejection are applicable.

See January 30, 2004 Office Action at page 4.

With respect to claim 2:

*The database containing a plurality of foreign protocols being associated with different realms is an inherent feature of the conversion platform (112) and the protocol services modules which provide a conversion between the different protocols of the different service providers to allow a client application to communicate with servers of multiple service providers.*

See *id.* at page 4 (emphasis in original). With respect to claims 11, 13, 14, 17-20, and 23:

*The aforementioned limitations are inherent features of the instant messaging systems. Auerbach discloses wherein the different service providers each support multiple features and capabilities that allow multipoint, multiprotocol communication as disclosed by Auerbach.*

See *id.* at pages 4-6 (emphasis in original). Thus, Applicant understands that each claim of the present application stands rejected, either explicitly or implicitly, because they include limitations that are “inherent features of instant messaging systems.” However, Applicant does not understand the specific rationale upon which that rejection is based.

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Applicant submits that the a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. *See* Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *See id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

*In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicant respectfully submits that neither the Auerbach ‘937 patent itself nor the Office Action “make[s] clear that the missing descriptive matter,” said to be inherent of all instant messaging systems, “is necessarily present in” the Auerbach ‘937 patent.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

*Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Applicant respectfully submits that the Office Action does not contain a basis in fact and/or technical reasoning to support the various rejections based on inherency. Instead, as recited above, many of the claims of the present application stand rejected based on conclusory

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statements of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, Applicant respectfully submits that, absent a "basis in fact and/or technical reasoning" for the rejection of record, that rejection should be reconsidered and withdrawn.

**III. Fee Calculation For New Claims**

As mentioned above, new claims 25-102 have been added, of which claims 25, 41, 56, 68, 82-84, and 100 are independent claims. The fee for claims in excess of twenty is \$18 per claim, while the fee for independent claims in excess of three is \$86 per claim. The fee for new claims 25-102 is calculated below:

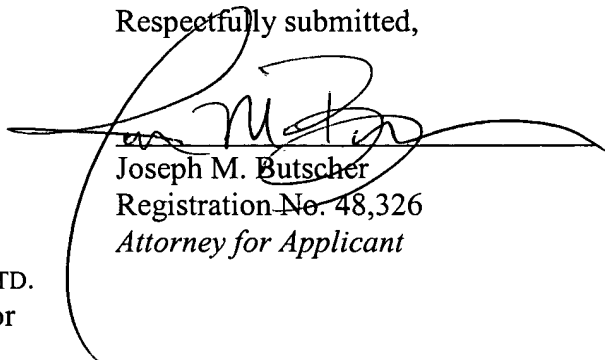
78 additional claims in excess of twenty X \$18 = \$1404  
8 additional independent claims in excess of three X \$86 = \$688

**TOTAL = \$2092**

A check in the amount of \$3042, which includes the fee for new claims and the fee for the Petition for Three Month Extension is enclosed. If the Examiner has any questions or Applicant can be of any assistance, the Examiner is invited to contact the undersigned. The Commissioner is authorized to charge any additional necessary fees not covered by the enclosed check or credit any overpayment to Account No. 13-0017.

Respectfully submitted,

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